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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,934	01/13/2004	David Bassett	Bassett.1563	3274
27547	7590	10/10/2006	EXAMINER	
GORDON & RAES LLP 101 WEST BROADWAY, SUITE 1600 SAN DIEGO, CA 92101			WILLSE, DAVID H	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/756,934	BASSETT, DAVID	
	Examiner	Art Unit	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-16-04</u> . | 6) <input type="checkbox"/> Other: _____ |

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure is objected to because on line 6, "increase" should be replaced by --increases--. Correction is required (MPEP § 608.01(b)).

The disclosure is objected to because of the following informalities: On page 4, line 9, "mechanism" should be replaced by --mechanisms--; on line 16, "a", second occurrence, should be replaced by --an--. On page 10, line 14, "an" should be replaced by --a--. On page 19, line 17, "when" should not be capitalized. On page 21, line 13, "be" should be deleted. In claim 15, line 2, "used" should be replaced by --use--. Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner is unfamiliar with polycentric knee designs taking on the form of element 11 in the Applicant's Figure 4, and the drawings do not adequately convey to the ordinary practitioner the mechanical connections (pivotal, fixed, or otherwise) among the disclosed components. Thus, the disclosure fails to enable a system in which a posterior linkage, a cam mechanism, and a braking mechanism including a polycentric knee operate *together* to provide a prosthetic knee mechanism (specification: page 1, lines 8-11; claims 35 and 36).

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 16-19, 34, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 2 and 34, line 2 of each, "an upper joint member" is confusing in that such a feature is introduced in claim 1, line 2, and claim 20, line 3. In claim 3, line 2, "the polycentric design" lacks a proper antecedent basis. In claims 16-19, lines 1-2 of each, "said posterior linkage *member*" (emphasis added) lacks a proper antecedent basis. In claim 35, line 2, "the polycentric design" lacks a proper antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Biedermann et al., WO 01/43668 A1: English abstracts; Figures 6-9.


Claims 13-17 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Didier, US 2,000,066, which discloses a linking assembly (Figure 3) and a posterior linkage assembly comprising leaf spring 28 (page 2, first column, line 45 et seq.).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Didier, US 2,000,066. Composite materials having appropriate mechanical characteristics for leaf springs were well known in the art at the time of the present invention and would have been an obvious material upgrade in order, for example, to reduce the weight of the prosthesis.

Claims 1-16, 19-30, and 33-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Panchenko et al., SU 1428371 A1, which discloses anterior and posterior linking or linkage assemblies comprising the plates **5**, mechanical braking mechanisms involving the controlled hydraulic resistances **19** and **20** (Derwent abstract, line 1), a cam system (figures; Derwent abstract), a shaft or shank **7**, and a piston (Figures 1 and 2). Regarding claims 15, 16, and others, virtually any material, including posterior plate **5**, possesses inherent elastic moduli and is elastically deformable to some extent.

Claims 17, 18, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panchenko et al., SU 1428371 A1. The plates **5** being of a high tensile metal or a composite material would have been obvious from respective well known advantages pertaining to strength, fatigue resistance, and so on.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and sometimes on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Dave Willse
Primary Examiner
Art Unit 3738